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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/646,382	08/21/2003	Kazuei Yamaguchi	NMCIP044	9725
22434	7590	04/18/2005	EXAMINER	
BEYER WEAVER & THOMAS LLP P.O. BOX 70250 OAKLAND, CA 94612-0250			ZIRKER, DANIEL R	
			ART UNIT	PAPER NUMBER
			1771	
DATE MAILED: 04/18/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/646,382

Applicant(s)

YAMAGUCHI ET AL

Examiner

Daniel Zirker

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

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1. The Examiner notes that applicants' "Brief Description of the Drawings" fails to mention Figures 1B and 1C, and it should accordingly be so corrected.

2. The following is a quotation of the second paragraph of 35 U.S.C. § 112:
The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicants regard as their invention.

3. Claims 6 and 7 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicants regard as the invention. More particularly, in each of these claims it appears that the chosen Markush language is improper in that since each of the claims depends upon claim 5 which already has a Markush group, it should state that the adhesive agent --includes-- rather than "is" which is believed to be proper Markush format in this particular situation, such as is already seen in applicants' claim 4.

4. The following is a quotation of the first paragraph of 35 U.S.C. § 112:
The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying

out his invention.

5. Claims 1 and 3-8 are rejected under 35 U.S.C. § 112, first paragraph, as based on a disclosure which is not enabling.

More particularly, the roughness of the adhesive layer such as is set forth in Table 2 and the corresponding disclosure, particularly at page 5 of the specification, teach that the improved roughness values obtained, i.e. the smoothness of the adhesive layer outer surface, when release sheets as that of PET are used appears to be critical or essential to the practice of the invention, but not included in the claim(s) is not enabled by the disclosure. See *In re Mayhew*, 527 F.2d 1229, 188 USPQ 356 (CCPA 1976).

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

7. A person shall be entitled to a patent unless --
(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 1-9 are rejected under 35 U.S.C. § 102(b) as being anticipated by Tsujimoto et al. Note particularly Figure 4, as well as Figures 5 and 6, and column 5, line 38 - column 6 line 14. The Examiner initially notes that the contemplated

method of usage language, i.e. "for attaching a polishing pad to a polisher and for backing a polishing pad and a polishing tape" (claim 1) and similar language in claim 8 is a patentably insignificant method of contemplated usage with respect to the claimed genus of articles. The reference clearly discloses, as is most commonly seen in Figure 4, a double sided adhesive tape which can comprise an adhesive film such as PET coated on each surface with a suitable pressure sensitive adhesive and having on one outer surface a non-shrink film 24 which can be either polypropylene or PET, which is substantially all applicants' claims require. Note that with respect to claim 6 the Examiner believes that since the reference discloses an adhesive agent which is an organic adhesive agent as required by claim 5, this claim is accordingly also anticipated. Additionally, note that although claim 8 expressly recites only the presence of a single adhesive layer, the claim is comprising in nature and therefore the reference clearly anticipates both this claim and claim 9 as well.

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Note particularly Uemura et al., which is related to applicants' field of contemplated use, that is involving polishing semiconductor wafers with adhesive sheets and tapes, U.S. PG Publication

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2003/0203193A1 to Murata et al., and Noguchi et al.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel Zirker whose telephone number is (571) 272-1486. The examiner can normally be reached on Monday-Thursday from 8:30 A.M. to 6:00 P.M. The examiner can also be reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris, can be reached on (571) 272-1478. The fax phone number for this Group is (703) 872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either private PAIR or public PAIR. Status information for unpublished applications is available through private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Dzirker:cdc

April 14, 2005

**DANIEL ZIRKER
PRIMARY EXAMINER**

Daniel Zirker